REMARKS

In the application claims 7-10 and 13-27 remain pending. Claims 1-6 and 11-12 have been canceled without prejudice. Certain of the pending claims have been amended to ensure proper antecedent bases and the amendments find their support in the specification, figures, and claims as originally filed. No new matter has been added.

All of the pending claims presently stand rejected. The reconsideration of the rejection of the claims is respectfully requested.

In the Office Action, claims 1, 3, 5-6, 11, and 12 were rejected under 35 U.S.C. § 103 as being rendered obvious by Amro (U.S. Patent No. 6,507,762) in view of Takechi (JP 09-280557). Since claims 1, 3, 5-6, 11, and 12 have been canceled, it is respectfully requested that this rejection now be withdrawn.

The remaining, pending claims stand rejected under 35 U.S.C. § 103 as being rendered obvious primarily by Allport (U.S. Patent No. 6,104,334) in view of Takechi. In rejecting the claims, the Office Action asserted that Allport teaches a method of displaying information to a consumer relevant to the operation of a consumer appliance including receiving at a Web server data that functions to identify the consumer appliance (citing to Fig. 15, items 10, 65, 420 discussed at Col. 22, lines 10-33), using the data at the Web server to retrieve an electronic document (IR command library) for the purpose of operating the consumer appliance that is identified by the data (again citing to Fig. 15, items 10, 65, 420 discussed at Col. 22, lines 10-33), and transmitting the electronic document from the Web server to a hand-held device whereby a representation of the electronic document is displayable on the hand-held device. While it was acknowledged that Allport does not disclose an electronic document comprising human-readable information, it was asserted that such was disclosed in Takechi and it "would

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have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the teaching of Takechi into Allport in order to enable a repair man to execute repair even when a manual is not at hand."

In response it is respectfully submitted that a rejection under 35 U.S.C. § 103 requires, among other things, that each and every element set forth in the claims be found, either expressly or inherently, in the references being relied upon. To be "inherently" described in a prior art reference, the prior art reference "must make clear that the missing descriptive matter is necessarily present in the thing described and that it would be so recognized by persons of ordinary skill." Inherency "may not be established by probabilities or possibilities." The mere fact that a certain thing may result from a given set of circumstances is not sufficient. *Continental Can Co. USA v. Monsanto Co.*, 948 F.3d 1264, 20 USPQ2d 1746 (Fed. Cir. 1991).

Turning now to Allport, it is respectfully submitted that Allport fails to expressly describe at least the claim elements relating to "entering into a hand-held device data that functions to identify a consumer appliance," "uploading the data that functions to identify the consumer appliance from the hand-held device to a Web server," and "using the data that functions to identify the consumer appliance at the Web server to retrieve an electronic document" when those claim elements are considered *in combination*. In particular, considering Col. 22, lines 10-33 (which was cited to in the Office Action) it is noted that nowhere within Col. 22, lines 10-32 is expressly described that anything is "uploaded" from the remote control to a Web server:

> The "update system" screen 65 is shown in FIG. 15. This screen presents the consumer with soft keys for various options to update system variables. For example, if the consumer changes internet service providers (ISPs), the requirements for accessing the ISP can be updated using soft key 410 labeled "new/changed information source." Similarly, if the access method is changed (e.g., from one of USB, IrDA, RS232, modem, etc. to another of USB, IrDA, RS232, modem, etc.), this information may be communicated to the remote control 10 by a soft key 415 labeled "new/changed connection." Another

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available option is to identify a new device to or delete an old device from the devices known to the remote control 10. This is accomplished from a soft key 420 labeled "new/changed device." For identifying a new device, the IR command library for the device must be loaded into the memory of the remote control 10. If the proper library is certain, for example if the library is associated with the exact make and model of the device, then the identified library may simply be loaded. If, however, it is not certain whether the library to be loaded is the proper library, the consumer may be required to load the library and then test the remote control 10 to determine if the library was the correct library. This may have to be repeated until the proper library is verified.

More particularly, it is respectfully submitted that the concept of "uploading" fails to be expressly described <u>anywhere</u> within Allport. Thus, since Allport fails to expressly describe, teach, or suggest the claimed causing data that functions to identify a consumer appliance to be uploaded from a hand-held device to a Web server which uses the uploaded data to retrieve an electronic document for the consumer appliance identified by the data, the combination of Allport and Tekechi cannot be said to expressly include each and every element set forth in the pending claims. For this reason, a prima facie case of obviousness has not been established and the rejection of the claims must be withdrawn.

By way of further explanation, it is respectfully submitted that Col. 22, lines 10-32 of Allport describes nothing more than methods for interacting with the remote control *to change the internal, local settings of the remote control.* For example, the cited passage describes nothing more than a user interacting with the remote control to change the internal, local settings of the remote control related to requirements for accessing an ISP (i.e., to change the address and communication method used when accessing the company that provides access to the Internet which, when the device is equipped with a modem, allows a user to log-on to the Internet and browse the World Wide Web), to change the devices the remote is configured to control, etc.

Considering the disclosure in Col. 22, lines 10-32 of Allport directed to changing the internal configuration of the remote control to allow access to an ISP, it is respectfully

questioned how this disclosure can be said to inherently describe uploading data that functions to

identify a consumer appliance to a Web server. Since this disclosure clearly has nothing to do

with uploading data to an ISP, instead only pertaining to accessing an ISP, it is respectfully

submitted that this disclosure from Allport fails to inherently provide the disclosure necessary to

maintain the rejection under 35 U.S.C. § 103 and, for this reason, the rejection of the claims must

be withdrawn.

Similarly, considering the disclosure in Col. 22, lines 10-32 directed to changing the

internal configuration of the remote control of Allport by selecting an IR library to load into

memory, it is noted that supplying the configuration data to the device of Allport only causes the

device of Allport *to load into memory an IR library selected from a set of IR libraries that have*

been previously provided to the remote control of Allport, i.e., the IR library is downloaded into

the remote control prior to the process of identifying the consumer appliance for the purpose of

configuring the remote control and not in response to the process of identifying the consumer

appliance. In this regard, Allport describes that the IR library for a specific device could be

downloaded from the Internet or other data source:

> Another example of the type of data that the remote control 10 could download is
> of course the IR libraries or protocols for specified devices. Though the remote
> control 10 will preferably be pre-loaded with a significant set of IR libraries for
> known manufacturers and devices, there may be some devices for which the
> protocols are not pre-loaded. In the latter case, the data (IR protocol) for a
> specific device could be loaded from the internet or other data source.

(Col. 26, lines 9-17).

As further described within Allport, this method for downloading an IR library to augment the IR

libraries already installed within a remote control and then selecting from these already installed

IR libraries an IR library to load into memory is *in keeping with conventional practice* (i.e.,

practices at the time Allport was filed):

> One of the most powerful aspects of the remote control of the present invention is its ability to interact with and gather data from the internet or other data sources such as a PC, and make use of a wide variety of data thus obtained. Specifically, the remote control is capable not only of downloading device configuration information (i.e., IR command libraries) from the internet **as existing universal remotes are,** but is capable also of receiving other internet data that can be used in interacting with the controlled devices.

(Col. 5, lines 56-63, emphasis added).

From this plain language of Allport, while Allport discloses downloading IR command libraries "as existing universal remote controls do," Allport does not make clear that the missing descriptive matter of "causing data that functions to identify a consumer appliance to be uploaded from a hand-held device to a Web server" and "using the data that functions to identify the consumer appliance at the Web server to retrieve an electronic document for the consumer appliance identified by the data" is necessarily present in the thing described. Rather, this disclosure of Allport can be said to suggest using the "conventional" method of downloading IR libraries such as described in, for example, commonly assigned U.S. Patent No. 4,959,810 (which sets forth a method by which an IR library for a specific device is downloaded from a data source <u>prior to</u> configuration of the remote control) and the "conventional" method of "loading, testing, and loading" IR codes sets from the previously downloaded IR libraries to configure the remote control to command operations of an appliance such as described in, for example, commonly assigned U.S. Patent No. 5,614,906 (which sets forth a method for configuring a remote control by repeatedly loading and testing prior installed IR code sets). Accordingly, since the disclosure in Allport related to "downloading IR libraries" can be said to do nothing more than impermissibly "establish by possibilities" the claim elements set forth in the Office Action, it is respectfully submitted that Allport fails to inherently provide the

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disclosure necessary to maintain the rejection under 35 U.S.C. § 103 and, for this reason, the rejection of the claims must be withdrawn.

It is further respectfully submitted that the disclosure within Takechi cannot be said to suggest modifying the system of Allport to include those claim elements that have been acknowledged to be missing from Allport. In this regard, it is submitted that Takechi teaches nothing more than the desirability of causing an instruction manual stored *within an appliance* to be downloaded to a hand-held controller *in response to the appliance detecting an internal abnormality or failure* to thereby allow "a repair man to execute repair even when a manual is not at hand." What Takechi does not disclose, teach, or suggest, however, is the desirability of providing a centralized Web server which receives uploaded data that functions to identify an appliance (it being noted that in Takechi the appliance having the instruction manual would already know its identity) where the centralized Web server can respond to the uploaded data to select an electronic document comprising human-readable information in a form for instructing a consumer how to interact with one or more controls of the consumer appliance so identified. Thus, for the further reason that Takechi fails to disclose, teach, or suggest modifying Allport in the manner set forth in the Office Action, it is respectfully submitted that a prima facie case of obviousness has not been established and the rejection of the claims must be withdrawn.
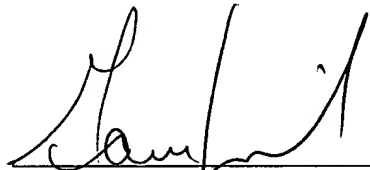
CONCLUSION

It is respectfully submitted that the application is in good and proper form for allowance.

Such action of the part of the Examiner is respectfully requested. Should it be determined,

however, that a telephone conference would expedite the prosecution of the subject application,

the Examiner is respectfully requested to contact the attorney undersigned.

The Commissioner is authorized to charge any fee deficiency or credit overpayment to

deposit account 50-2428 in the name of Greenberg Traurig.

Respectfully Submitted;

Date: October 14, 2004   By:

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